

REMARKS

Concerning the Amendment to the Specification

Claim 28 is amended to conform the specification to the claims as originally filed. Support for the amended specification is found in the claims as originally filed, including claims 5, 6, and 12. Inclusion of the description of the invention in the specification based on originally filed claims does not add forbidden 'new matter' and is supported by decisional law. *In re Smith*, 178 USPQ 620, 624 (CCPA, 1973).

Concerning the Amendments to the claims

Claim 1 is amended to change verb form to establish an "open", rather than "closed" claim. The claimed acid scavengers are identified more specifically. The acid scavengers selected were disclosed in claims 3 and 4 as originally filed as well as the specification at paragraphs [0026 – 0028]. No new matter is added.

Claims 3 and 4 more narrowly specify the claimed acid scavengers. No new matter is added.

Claims 4 and 5 are amended to conform to the preferred form for Markush type claims. No new matter is added.

Claim 8 is amended to identify the claimed acid scavengers more specifically. The acid scavengers selected were disclosed in claims 3 and 4 as originally filed as well as the specification at paragraphs [0026 – 0028]. No new matter is added.

Claims 10 and 11 are amended to more narrowly specify the claimed acid scavengers. No new matter is added.

Concerning Rejections for Lack of Enablement

A. The Office Action dated 09/28/2004 urges a rejection of Claims 1, 2, 8, and 9 over 35 USC §112, first paragraph, for lack of enablement directed to acid scavengers.

The specification identifies the properties of useful scavengers, and the properties of acid scavengers that are not useful. Paragraphs [0026 – 0030] Moreover, the applicant lists several acid scavengers and classes of compounds having characteristics of useful scavengers.

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Applicant submits that a person skilled in the art of polyurethane foam upon reading the specification and claims as originally filed will conclude that the specification and claims as originally filed fully supports the claims and evidences that the Applicant was in possession of the subject matter claimed. *Amgen v Chugai*, 927 F.2d. 1200, 18 USPQ2d 1016, 1026 (Fed.Cir., 1991). Experimentation by a person skilled in the art is guided by the suggestion to avoid materials adversely impacting the polyurethane reaction yielding foam with poor physical properties. Undue experimentation is not required. *Id.*

B. The Office Action dated 09/28/2004 urges a rejection of claims 5 -7 and 12 – 14 over 35 USC §112, first paragraph, based on the assertion that a recited carboxylic acid may not be an acid scavenger.

The specific acid scavengers listed appeared in the original claims, and thus are supported by the specification. The Office Action asserts that "carboxylic acids are not listed species in the broader listing of acid scavengers from which these claims depend." page 2. Claim 12 does not reference, or depend from a claim that references a carboxylic acid. Thus the rejection is not clear as to claim 12. Considering claims 5 – 7, 13 and 14, as to whether the claimed species: 7-Oxabicyclo[4.1.0]heptane-3-carboxylic acid is, or is not, an acid scavenger as defined by the specification, Applicant submits no support for the Examiner's position is provided in the Office Action. Applicant calls upon the Examiner to provide support pursuant to 37 CFR §1.104(d)(2) for the position asserted: that 7-Oxabicyclo[4.1.0]heptane-3-carboxylic acid is not an acid scavenger as the term is used in the specification. Absent such support, the claim must be deemed fully enabled by the specification.

C. The Office Action dated 09/28/2004 urges a rejection of claims 5 -7 and 12 – 14 over 35 USC §112, second paragraph, for a failure to particularly point out and distinctly claim the subject matter which the applicant regards as his invention. The Office Action urges that the carboxylic acid species recited in claims 5-7 and 12 -14 does not appear to be an acid scavenger.

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The response above concerning the rejection pursuant to 35 USC §112, first paragraph, for the same reason is equally applicable to this rejection under 35 USC §112, second paragraph,. Applicant calls upon the Examiner to provide support pursuant to 37 CFR §1.104(d)(2) for the position asserted.

Concerning Prior Art Rejections pursuant to 35 USC §102(b)

Reference 3,957,702 discloses preparation of a phosphorus-containing starch product (Col. 2, lines 18 – 23) prepared from starch polyether hydrolysates (Col. 3, lines 59 – col. 4, line 3) thereafter reacted with a phosphorus oxyacid. (Col. 5, lines 44 – 49) In a preferred embodiment the phosphorus-containing intermediate is prepared by the reaction of the inorganic phosphoric acid with a starch polyether (or hydrolysate thereof) which has been prepared by the reaction of starch, urea and an alkylene oxide having from 2 to 5 carbon atoms in the alkylene group. (Col. 6, lines 6 – 16). The Office Action identifies no teaching or suggestion that any unreacted alkylene oxide remains after preparation of the phosphorylated starch. The phosphorylated starch is proposed as a flame retardant for polyurethane foam. (Col. 2, lines 12 – 18) So far as Applicant can determine, the '702 reference relates to acid scavengers limited to nitrogen containing molecules. (Col. 6, lines 53 – 61), So far as Applicant can determine, no recitation of the claimed acid scavengers in the urethane reaction is disclosed by the reference.

Accordingly, the '702 reference does not anticipate the claimed acid scavengers in the preparation of polyurethane foams as claimed by Applicant. Applicant requests the rejection over 35 USC §102(b) be withdrawn.

Concerning Prior Art Rejections pursuant to 35 USC §103(a)

Reference 5,194,453 is relied upon to reject claims 1 – 5, and 7 – 13 pursuant to 35 USC § 103 (b) in combination with references 5,958,993, 6,765,035, 5,728,760 and 4,748,192.

The '453 references is relied upon to describe a flexible polyurethane foam comprising "flexible, flame retardant polyurethane foams". (Office Action 09/28/2004, p. 4) The flame

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retardants disclosed are melamine, or chlorinated, flame retardants (Col. 4, 5 – 17; Col. 7, lines 63 – 64) Applicants claims are directed to brominated, not chlorinated, flame retardants.

The '993 reference is urged to disclose claimed brominated flame retardants, (Office Action 09/28/2004, p. 4) as is the '760 reference (*Id.*). The '035 reference is urged to disclose claimed phosphate flame retardants. (*Id.*). Missing from the combination of references is the claimed acid scavenging component.

The Office Action urges that the acid scavenging component is supplied by the '192 reference. The focus of the '192 reference is reaction-injection molding. (Col. 1, line 65 – col. 2, line 7) However, while the reference discloses acid scavenging, (Col. 5, lines 8 – 13) and foam prepared from the reaction of isocyanate and polyol, the utility of acid scavengers according to the '192 reference is limited to solid, not foamed, polymers. (Col. 6, lines 30 – 34). Thus, there is no teaching or suggestion in the '192 reference of a polyurethane foam incorporating an acid scavenger. Rather, the '192 reference teaches away from the use of acid scavengers in foam applications by limiting their use to "solid spray coatings".

Accordingly, Applicants claims are not rendered obvious by the combination of references of record. Applicant requests the rejection over 35 USC §103(a) be withdrawn.

Relief Requested

Applicants request that the amendment to the specification and claims requested by this Response be made of record in the application.

Applicants further request that the pending rejection of claims be withdrawn over the art of record for the reasons stated.

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In the event that Applicants have overlooked the need for an extension of time or a payment of fee, Applicants hereby conditionally petition therefore and authorize that any charges be made to Deposit Account No. 02-0390, BAKER & DANIELS.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Thomas A. Ladd", written in a cursive style.

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